

REMARKS

In response to the above Office Action, claim 1 has been amended to limit the inorganic filter to "a clay," support for which can be found in claim 3. As a consequence, claim 2 has been cancelled and claims 3 and 5 amended to reflect the amendment to claim 1. Claim 4 has also been cancelled.

New claim 6, dependent from claim 1, claims the particle size of the clay. Support for the claim can be found on page 11, lines 21-22 of the specification.

In the Office Action, the Examiner rejected claims 1 and 4 under 35 U.S.C. §102(e) for being anticipated by U.S. Patent No. 6,875,812 to Akiyama et al., hereafter Akiyama. Now that claim 1 includes the clay of claim 3 and claim 4 has been cancelled, it is believed this rejection is moot. Its withdrawal as a ground of rejection of the claims is, therefore, requested.

The Examiner also rejected claims 1, 4, and 5 under 35 U.S.C. §103(a) for being obvious over Akiyama in view of U.S. Patent No. 4,433,114 to Coran et al., hereafter Coran. Now that claim 1 includes the clay of claim 3, it is believed this rejection is also moot.

It is noted that the Examiner did not include either of claims 2 and 3 in any of the rejections of the claims, although the claims are indicated to be rejected in the Office Action Summary and the Examiner refers to "instant claims 1-3" on page 4, line 17 of the Office Action in the obviousness rejection based on Akiyama in view of Coran. Perhaps the Examiner intended to include these claims in the rejection under §103(a). Clarification of the rejection in the next Office Action is requested.

In any event, the primary reference to Akiyama does not disclose the use of clay as the inorganic filler. See, for example, column 15, lines 25-36 and claim 17.

Coran discloses clay in column 17. However, Coran is directed to a diene rubber whereas Akiyama and applicants' invention relate to resin compositions and, more particularly, to a polyphenylene ether based resin composition. Thus it is submitted that the only suggestion to combine the references with respect to the clay of claim 3 comes from a reading of applicants' specification and not from anything taught by these references. As noted by the Federal Circuit and as expressed, for example, in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985) at page 551:

When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.

In view of the foregoing, it is believed claims 1, 3, 5, and 6 are in condition for allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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